

REMARKS

Claims 1, 3-5, 7-10, 18-19, 24, and 28-36 were previously pending, of which claims 1 and 18, 28, 29 and 30 have been amended. Reconsideration of presently pending claims 1, 3-5, 7-10, 18-19, 24, and 28-36 is respectfully requested in light of the above amendments and the following remarks.

Allowable Subject Matter

Applicants note with appreciation the Examiner's statement that claims 29, 31, 32, and 36 would allowable if rewritten in independent form. Claim 29 has been amended to independent form and the remaining claims 30-32 and 34-36 depend therefrom.

Compliance with 35 U.S.C. § 102

Claims 1, 3-5, 7, 8, 10, 18, and 19 were rejected under 35 U.S.C. §102(b) as being anticipated by Ouchi (US Patent No. 6,206,904 B1). Claims 1, 3, 5, 7-9, 18, 19, 24, 28, 30, and 33-35 were rejected under 35 U.S.C. §102(b) as being anticipated by Reznik (US Patent No. 4,393,872) under a first interpretation. Claims 1, 3, 5, 7, 8, and 10 were rejected under 35 U.S.C. §102(b) as being anticipated by Reznik under a second interpretation.

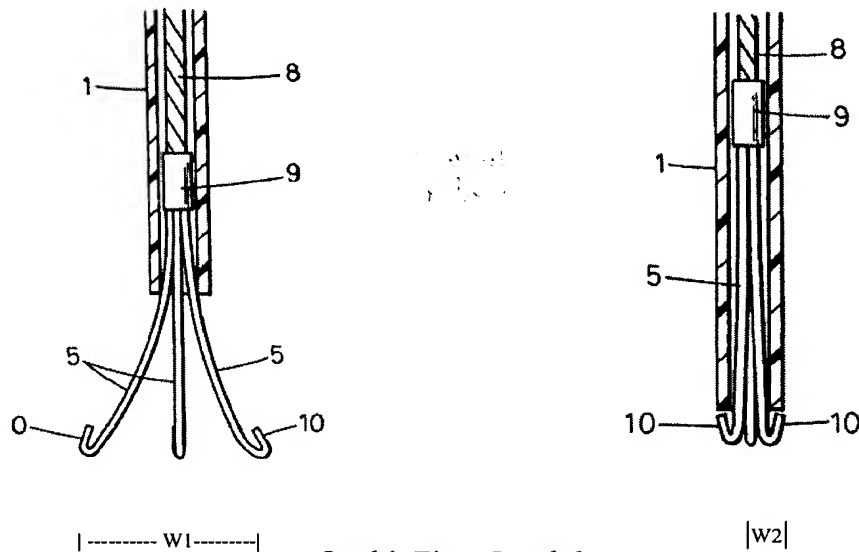
As set forth at MPEP §2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." With respect to the claims as herein amended, this rejection is respectfully traversed.

Amended claim 1 now requires:

A surgical instrument for extracting a prosthetic device, comprising:
a distal portion transitionable from an insertion configuration to an extraction configuration, wherein the insertion configuration is adapted for displacement along a portion of a prosthetic device, and the extraction configuration is adapted for engaging and extracting the prosthetic device, the distal portion having a natural bias towards the extraction configuration the distal portion including a first extraction prong with a first distal end extending along a longitudinal axis and a second extraction prong with a second distal end extending along the longitudinal axis, the first distal end being laterally spaced apart from the second distal end by a first width transverse to the longitudinal axis, the first extraction prong

extending distally from a first location and the second extraction prong extending distally from a second location, the first and second locations being laterally spaced apart from each other by a second width, and wherein the first width between the first and second distal ends of the extraction prongs is substantially the same in the insertion configuration and in the extraction configuration; and
a proximal portion connected to the distal portion.

Ouchi teaches that “[a] plurality of foreign body-catching arms 5 are bundled together at the proximal ends and inserted into a connecting pipe 9 and secured therein.” (Col. 4, lines 43-45 and Figs. 5-9, 13-14). In Fig. 5, four foreign body-catching arms are shown in an extraction configuration with engaging portions 10 spaced by a large width W1. (Col. 4, lines 23-25). In Fig. 6, the arms are shown in an insertion configuration with the engaging portions 10 spaced by a width W2, much smaller than W1. (Col. 4, lines 25-27).



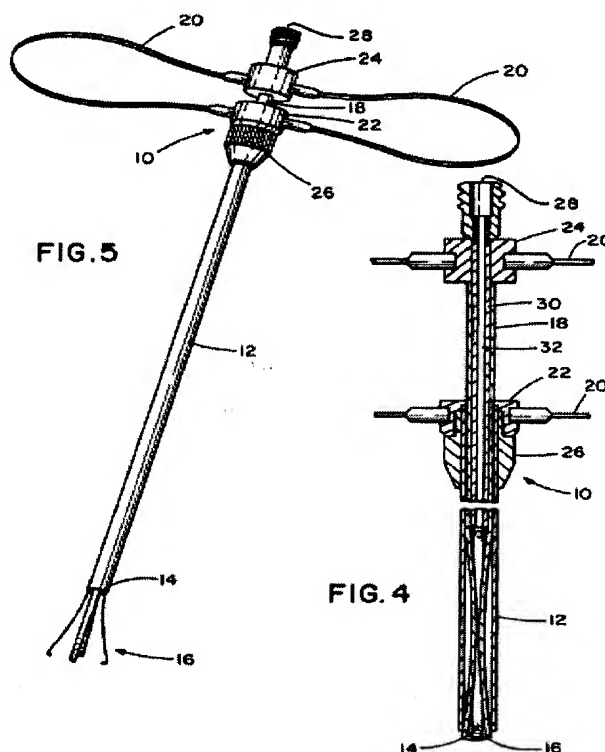
Thus, Ouchi fails to teach a:

distal portion including a first extraction prong with a first distal end extending along a longitudinal axis and a second extraction prong with a second distal end extending along the longitudinal axis, the first distal end being laterally spaced apart from the second distal end by a first width

transverse to the longitudinal axis, the first extraction prong extending distally from a first location and the second extraction prong extending distally from a second location, the first and second locations being laterally spaced apart from each other by a second width, and wherein the first width between the first and second distal ends of the extraction prongs is substantially the same in the insertion configuration and in the extraction configuration; and

Since the required elements of claim 1 are absent, the rejection is not supported by the Ouchi reference and should be withdrawn.

Reznik teaches inwardly facing prongs for capturing bone chips endoscopically. (Abstract and Col. 3, lines 1-6). In Fig. 5, the prongs 16 are shown in a widely spaced open configuration, which might be compared to Applicants' extraction configuration. (Col. 2, lines 42-45). In Fig. 4, the prongs 16 are shown in a tightly packed retracted configuration, which might be compared to Applicants' insertion configuration. (Col. 1, lines 50-54).



Reznik, Figs. 4 and 5

Thus, Reznik fails to teach a:

distal portion including a first extraction prong with a first distal end extending along a longitudinal axis and a second extraction prong with a second distal end extending along the longitudinal axis, the first distal end being laterally spaced apart from the second distal end by a first width transverse to the longitudinal axis, the first extraction prong extending distally from a first location and the second extraction prong extending distally from a second location, the first and second locations being laterally spaced apart from each other by a second width, and wherein the first width between the first and second distal ends of the extraction prongs is substantially the same in the insertion configuration and in the extraction configuration.

Since the required elements of claim 1 are absent, the rejection is not supported by the Reznik reference under the first or second interpretations and should be withdrawn.

Claim 18 recites “maintaining the first width between the first distal end of the first extraction prong and the second distal end of the second extraction prong.” For reasons similar to those set forth above with respect to claim 1, the method of amended independent claim 18 is not anticipated by the Ouchi or Reznik references.

Dependent claims 3-5, 7-10, 19 and 24, depend from, and further limit, independent claims 1 and 18, respectively, and therefore should be allowable as well.

Independent claim 28 requires:

a distal portion transitionable from an insertion configuration to an extraction configuration, wherein the insertion configuration is adapted for displacement along a portion of the prosthetic device, and the extraction configuration is adapted for engaging and extracting the prosthetic device, the distal portion further comprising:

a mounting block having a transverse slot;

an extraction portion including at least a first and a second flexible extraction prong, said first and second extraction prongs extending from the transverse slot from bilateral locations laterally spaced apart from each other, each of the first and second extraction prongs being adapted to be partially deformed when in an insertion configuration and having a natural bias toward the extraction configuration, and wherein *the first extraction prong deflects between*

the extraction configuration and the insertion configuration along a first plane and the second extraction prong deflects between the extraction configuration and the insertion configuration along a second plane different than the first plane, the first and second planes being substantially parallel to each other; and
a proximal portion including a substantially rigid shaft connected to the mounting block.

(Emphasis added)

Reznik teaches four prongs that can be expanded or retracted from a narrow tubular member. (Abstract, and see Fig. 5 above). If opposing prongs are considered, they will deflect between extraction and insertion configurations along substantially the same plane, rather than along two spaced apart, different parallel planes. If adjacent prongs are considered, their respective deflection planes will be intersecting rather than parallel. Thus, Applicants urge Examiner to reconsider whether Reznik can anticipate claim 28, especially in consideration of the foregoing.

Since the required elements of claim 28 are absent, the rejection is not supported by the Reznik reference and should be withdrawn.

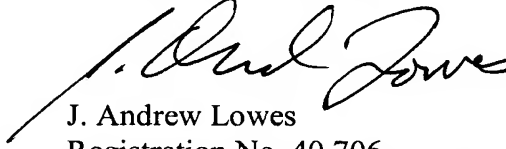
Compliance with 35 U.S.C. § 103

Claims 9 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ouchi (US Patent No. 6,206,904 B1) and claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Reznik (US Patent No. 4,393,872). Claims 4 and 9 depend from and further limit claim 1 and claim 30 depends from and further limits claim 29 in a patentable sense and therefore should be allowable as well.

Conclusion

Reconsideration of presently pending claims 1, 3-5, 7-10, 18-19, 24, and 28-36 is hereby respectfully requested. A notice of allowance is hereby respectfully requested. Should there remain any questions, the Examiner is invited to telephone the undersigned.

Respectfully submitted,


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<p>I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on the following date.</p> <p>Date: <u>November 29, 2007</u></p> <p><u>Diane Sutton</u></p> <p>Diane Sutton</p>
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